

III. REMARKS

1. Applicant respectfully submits that the Office Action is defective and a new, non-final action must be issued. The Examiner rejects claim 23 over Goldberg in view of Cardina and Makelaet. However, as previously pointed out to the Examiner, on more than one occasion, Makelaet is not prior art against Applicant's invention for purposes of 35 U.S.C. § 103(a). Makelaet is commonly owned by the assignee of the instant application, Nokia Mobile Phones, Ltd., and only qualifies as art under 35 U.S.C. §102(e). Thus, pursuant to 35 U.S.C. § 103(c), Makelaet, is not prior art for purposes of 35 U.S.C. § 103 (a).

This was explicitly presented before the Examiner in the response mailed on April 10, 2006, the response mailed on December 28, 2005 and the response mailed on October 8, 2004. However, the Examiner has failed to acknowledge this and once again wrongly asserts this defective basis of rejection in yet another office action. This has not only delayed prosecution of the application, but has caused the Applicant an unnecessary expense.

This rejection is *prima facie* invalid, and the rejection cannot stand. Thus, at least this claim must be allowable and the office action is defective. A new, non-final office action is required to be issued. It is noted that the undersigned contacted the Examiner to discuss this issue and the Examiner's response was for the Applicant to appeal.

2. Claims 1 and 2 are not unpatentable over Goldberg under 35. U.S.C. § 103(a).

Claim 1 recites a method for expressing an "affective state of the caller and/or called party." The musical composition heard by the recipient of the message represents the "affective state" of the sender of the message. No such disclosure is made by Goldberg.

Goldberg relates to inserting background sounds in a telephone call. (Abstract, lines 1-2). The calling party has to select the background sound that is inserted onto the telephone channel. (Abstract, lines 8-14). This is not Applicant's invention.

In the present application, claim 1 recites a method and claim 17 a system in which the affective state of the caller and/or called party is expressed to the conversation partner in a telephone conversation by a musical composition representing the affective state of the sender of the message. The recipient of the message hears the composition in the background of the conversation. The basic idea of the invention is that the musical composition reflects the state of mind (happiness, sadness, etc.) of the sender of a message (page 2, lines 9-12). Thus, the musical compositions are chosen particularly to express a certain state of mind or feeling of the caller/ called party. When the recipient of the message hears the musical composition, he/she understands the state of mind of the conversation partner and is able to better interpret the things said by the partner (page 2, lines 16-17). The aim of the invention is thus to help the conversation partners to understand each other better and to reduce the risk of misunderstandings and unintentional insults (page 2, lines 21-23).

Goldberg discloses a method for inserting background sound in a telephone call. The background sounds are not pure musical

compositions, but they can include restaurant sounds, forest sounds, beach sounds, city traffic sounds, etc. (Col. 2, lines 48-50). The only purpose of the background sound is to create to the called party an impression of the location of calling party (Col. 1, lines 21-28). Thus, the purpose of the background sound is not to express the affective state of the caller and/or called party and the sounds are not chosen accordingly, like in the present invention. In fact, Goldberg does not give any indication, that background sounds could reflect the state of mind of the conversation partners or that expressing the affective state of the caller/called party could make the conversation situation easier for the conversation partners.

Goldberg deals only with "background sounds" that reflect the "locale" of the caller. Thus, Goldberg suggest sounds like restaurant sounds, forest sounds, beach sounds, city traffic sounds, etc. (Col. 2, lines 48-50). There is simply no disclosure in Goldberg, let alone any suggested or inferred relationships between the "background sounds" of Goldberg and "musical compositions" that reflect the "affective state" of a person of Applicant's claims.

Any suggestion or inference to this possibility could only be made with hindsight knowledge of Applicant's claims and disclosure, which as noted previously, is impermissible. The Examiner has not shown or produced any evidence that would or can be used to correlate "background sounds" of Goldberg, such as "restaurant sounds", to a "musical composition" representing the "affective state" of a person, as claimed by Applicant, where the "affective state" corresponds to the "state of mind" or emotion of the person. It is respectfully submitted that the Examiner's taking of Official Notice that the "background sounds" of Goldberg are "equivalent" to the "musical

composition" representing the "affective state" of the sender has no basis in fact, and it is merely with hindsight knowledge of Applicant's claims that such a statement is made.

Evidentiary proof, as required, is once again requested to support this assertion.

Thus, it would not be obvious to one of skill in the art to modify Goldberg to provide a "musical composition representing the affective state of the caller or called party sending the message" as claimed by Applicant.

3. Claims 3-19 and 22 are not unpatentable over Goldberg in view of Cardina.

Claims 3-16 should be allowable at least by reason of their dependencies on claim 1. Claim 17 also deals with expressing an "affective state" of a caller, which as previously noted, is not disclosed or suggested by Goldberg. Cardina does not overcome at least these deficiencies and claim 17 should be allowable. Claim 22 should also be allowable at least by reason of its dependency.

4. Claims 20 and 21 are not unpatentable over Goldberg in view of Cardina and further in view of Armanto et al. ("Armanto") under 35 U.S.C. §103(a).

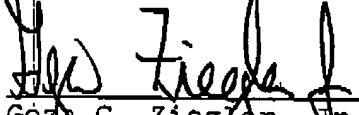
Claims 20 and 21 should be allowable at least by reason of their respective dependencies.

Furthermore, the combination of Goldberg, Cardina and Armanto does not disclose or suggest "a musical composition representing the affective state of the sender of the message" as recited in the claims. Any suggestion to do so can only be with hindsight knowledge of Applicant's claims.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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6 June 2006
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